

**REMARKS**

This is in response to the Office Action mailed April 22, 2005.

Withdrawn claims 6-9 are cancelled without prejudice or disclaimer of the subject matter therein. New claims 24-27 are submitted herewith.

The specification has been amended at page 3 to remove the word "approximately". Common ticket stock has a caliper characteristic of 9.5 and it is to be emphasized that such is different from the claimed characteristic of between 5 and 8.

**The Rejections.**

Claims 1-5, 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as unpatentable over applicant's submission of prior art (ASPA) in view of Friesch (U.S. Patent No. 5,489,453) and Takeda et al (U.S. Patent No. 3,963,821). Claim 19 is rejected under 35 U.S.C. 103(a) as unpatentable over ASPA in view of Friesch. Claims 1-5, 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as unpatentable over Austin, Jr. (U.S. Patent No. 4,071,201) in view of Friesch and Takeda et al. Claim 19 is rejected under 35 U.S.C. 103(a) as unpatentable over Austin, Jr. in view of Friesch. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as unpatentable over London (U.S. Patent No. 2,571,268) in view Takeda et al. Claim 22 is rejected under 35 U.S.C. 103(a) as unpatentable over London in view Takeda et al and Friesch.

**Claim 1.**

Claim 1 is directed to

a roll of tickets comprising a tube, and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween, the plurality of tickets being formed from a substrate having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98%.

**The rejection based on ASPA, Friesch and Takeda et al.**

At page 2 of the office action it is suggested that

it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with a caliper of 7, as taught by Friesch, to provide the

substrate with a dimension that reduces storage space and is economically manufactured.

It is well settled that an examiner cannot establish obviousness by locating references which describe various aspects of an applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the applicant has done.<sup>1</sup>

Neither ASPA or Friesch teach or suggest providing the ASPA tickets from a substrate having a caliper characteristic between 5 and 8 points. ASPA teaches a caliper characteristic of approximately 9.5, not less. Friesch discloses a container having a twin substrate. The first substrate is paper having a small enough caliper to allow for proper forming and to maintain the shape of the container once it is formed. The second substrate is a polyester film thin enough to allow the paper substrate to maintain its shape, but sufficiently thick to hold the adhesive or other material to be stored. The first and second substrates are glued together with a water-based or hot melt pressure-sensitive adhesive. At column 2, lines 60 Friesch states "[i]n the preferred embodiment, 60 pound offset paper having a caliper of 7 or less is used in the paper substrate." This disclosure is not a teaching or suggestion to use paper having a caliper of 7 to provide a ticket. Friesch's teaching that paper having a caliper of 7 is known for use in combination with another layer of material does not provide a suggestion or motivation to modify ASPA to provide a substrate having a caliper characteristic between 5 and 8 points as recited in claim 1 and it would not have been obvious to one of ordinary skill in the art to combine ASPA and Friesch.

The statements at pages 9 and 10 of the office action urge that it would have been obvious to provide the substrate of ASPA with a caliper characteristic of 7. The prior art characteristic of 9.5 does not teach or suggest the range of caliper in applicant's claims.

The problems associated with using thinner tickets have discouraged creation of a thinner ticket. In the present instance, there is no persuasive evidence of a motivating force to combine ASPA and Friesch in a manner that would have arrived at the invention of claim 1. The reasoning stated for the combination of ASPA and Friesch is to reduce storage space and to provide the substrate is economically manufactured. These are purely speculative and without basis. Making thinner tickets may be more costly, not more economical. Making thinner tickets may require more packing for storage. There is nothing in the prior art to suggest the alleged advantages.

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<sup>1</sup> See Ex parte Levengood, 28 USPQ2d 1300, (BPAI 1993).

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art.<sup>2</sup> In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teaching to arrive at the claim invention.<sup>3</sup> To this end, the requisite motivation must stem from some teaching suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from appellant's disclosure.<sup>4</sup>

For at least these reasons, the combination of ASPA and Friesch would not have been obvious to one of ordinary skill in the art.

At pages 2 and 3 of the office action it is suggested that

it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the substrate as disclosed by ASPA with an opacity value less than 98%, as taught by Takeda et al., to optimally obscure the appearance of the substrate.

Takeda et al disclose a method for producing a synthetic fiber. At Table 2 of Takeda et al it is disclosed that properties of paper include opacities of 97%, 95%, 92%, etc. The caliper of such papers is not disclosed. There is nothing in Takeda et al that would have taught or suggested using paper with an opacity of less than 98% in a ticket having a caliper of between 5 and 8 as recited in claim 1. Takeda et al's teaching that paper having an opacity of less than 98% is known is not a suggestion or motivation to modify ASPA to provide a substrate of paper having an opacity of less than 98% as recited in claim 1 and it would not have been obvious to one of ordinary skill in the art to combine ASPA and Takeda et al. The reasoning given for the combination, i.e., to optimally obscure the appearance of the substrate, is without regard for the importance of being able to read surface or imbedded information in the ticket. One of ordinary skill would have understood this and would not have arbitrarily decided that it is an advantage to provide an opacity of less than 98%. Other factors must be considered.

For at least these reasons, the combination of ASPA and Takeda et al would not have been obvious to one of ordinary skill in the art.

It is improper to pick from the prior art only so much as will support a given position, to

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<sup>2</sup> See, for example, *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

<sup>3</sup> See *Ex parte Clapp*, 2227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985).

<sup>4</sup> See, for example, *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 A(Fed. Cir.), cert denied, 488 U.S. 825 (1988).

the exclusion of other parts necessary to the full appreciation of what such references fairly suggest to one of ordinary skill in the art.<sup>5</sup> The above noted rejection of claim 1 appears to pick and choose elements from the Friesch and Takeda et al references without regard for the teachings of such prior art.

The court has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art.<sup>6</sup> It is apparent that the proposed modification of ASPA to provide paper having a caliper of 7 as disclosed by Friesch and paper with an opacity of less than 98% as taught by Takeda et al. is not motivated by some teaching or suggestion in the prior art. Rather the combination was constructed only after a hindsight review of the applicant's disclosure. The office action does not supply a factual basis for the rejection, but relies on speculation for suggesting the combination. Such hindsight conclusion based on a hindsight review of the applicant's disclosure is improper.

The rejection based on Austin, Jr., Friesch and Takeda et al.

The rejection at page 5 of the office action is the same as the rejection of claim 1 based on ASPA, Friesch and Takeda et al. The combination of Friesch and Takeda et al with Austin, Jr. is no better than the combination of ASPA, Friesch and Takeda et al. Applicant submits that this rejection is improper and the reasoning is the same with Austin, Jr. replacing ASPA in applicant's above remarks with respect to claim 1.

Claims 2-5.

Claims 2-5 depend from claim 1 (directly or indirectly) and avoid the prior art for the same reasons as noted above with respect to claim 1.

Claims 10-13 and 15-17.

Claim 1 is directed to

a roll of tickets comprising a tube, and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween,

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<sup>5</sup> See *In re Kamm*, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972) .

<sup>6</sup> See, e.g., *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

the plurality of tickets being formed from a substrate having an opacity of less than 98%.

At page 4 of the office action it is stated that “[r]egarding claims 5, 10, 11, 12 and 18, see the above rejections to claim 1.”

The rejection of claim 10 and dependent claims 11-13 and 15-17 is improper because the combination of ASPA, Friesch and Takeda et al are not obvious for the reasons expressed above.

#### Claim 18.

Claim 18 is dependent on claim 10 and further adds that the substrate has a caliper characteristic in the range of from 5 to 8 points. For the reasons expressed above, it would not have been obvious to combine ASPA, Friesch and Takeda et al and such combination would not have arrived at the subject matter of claim 18.

#### Claim 19.

##### The rejection based on ASPA and Friesch.

Claim 19 is directed to a plurality of tickets comprising a sheet of reply card stock paper having a caliper in the range of from 5 to 8 points and having perforations defining detachable tickets therebetween.

Claim 19 is rejected over ASPA in view of Friesch. The reasoning stated in the office action is the same as stated with respect to claim 1. Applicant submits that the rejection is improper for the same reasons as expressed above with respect to the rejection of claim 1 based on ASPA and Friesch.

##### The rejection based on Austin, Jr. and Friesch.

Claim 19 is rejected over Austin, Jr. in view of Friesch. The reasoning stated in the office action is the same as stated with respect to claim 1. Applicant hereby states that the rejection is improper for the same reasons as expressed above with respect to the rejection of claim 1 based on Austin, Jr. and Friesch.

#### Claims 21 and 23.

Claim 21 is directed to

a plurality of tickets comprising a strip of reply card stock paper having an opacity of less than 98% and having perforations

defining detachable tickets therebetween, the strip being folded along at least some of the perforations to form a deck of tickets.

Claims 21 and 23 are rejected over London in view of Takeda et al.

London teaches a ticket pad and at column 3, lines 37-40 it is stated “the tickets are 2” long, 1” wide, and of such thickness and stock that the pad of 2,000 tickets, 400 folds, so folded, is 5” high, as well as being 10” long and 1” wide”. London does not otherwise relate ticket stock or ticket opacity.

There is nothing in Takeda et al that would have taught or suggested using paper with an opacity of less than 98% in a ticket. Takeda et al’s teaching that paper having an opacity of less than 98% is known is not a suggestion or motivation to modify London to provide a substrate of paper having an opacity of less than 98% as recited in claim 21 and it would not have been obvious to one of ordinary skill in the art to combine London and Takeda et al. The reasoning given for the combination, i.e., to optimally obscure the appearance of the substrate, is without regard for the importance of being able to read surface or imbedded information in the ticket. One of ordinary skill would understand this and would not have arbitrarily decided that it is an advantage to provide an opacity of less than 98%. Other factors must be considered.

For at least these reasons, the combination of London and Takeda et al would not have been obvious to one of ordinary skill in the art.

Claim 23 is dependent on claim 21 and adds that each ticket has a marking imprinted thereon for triggering a light and sensor ticket-counting device. Depending on which side of the ticket the imprint is placed, the opacity may be key to the use of the light and sensor. This feature is not taught or suggested by any of the prior art of record.

Claim 22.

Claim 22 is dependent on claim 21 and further requires the caliper characteristic is in the range of from 5 to 8 points.

The rejection at page 9 of the office action urges claim 22 is unpatentable over London in view of Takeda et al and Friesch. This is the same as the rejection of claim 1 based on ASPA, Friesch and Takeda et al with London replacing ASPA. The combination of Friesch and Takeda et al with London is no better than the combination of ASPA, Friesch and Takeda et al. Applicant submits that this rejection is improper and the reasoning is the same with London replacing ASPA in applicant’s above remarks with respect to claim 1.

Additional comments on the above-noted rejections.

The statement that “it would have been an obvious matter of design choice” is used in, for example, the rejection of claims 3, 15 and 17 (page 3 of the office action) and this is a conclusion, not a reason. Accordingly, there is no prima facie case and no proper rejection of the claims on this basis.

At, for example, page 6 of the office action it is stated that discovering an optimum value of a result effective variable involves only routine skill in the art. The prior art of record does not establish that any of the claimed elements are a result-effective variable. Therefore, the rejections based on this premise is improper. See *In re Antonie*, 559 F.2d 618, 195USPQ 6 (CCPA 1977) and MPEP 2144.05 at II B and III.

Conclusion.

In view of the above, it is submitted that all of the pending non-withdrawn claims (Nos. 1-5, 10-13, 15-19 and 21-27) are in condition for allowance and such action is, respectfully, requested.

If there is any issue remaining to be resolved, the examiner is invited to telephone the undersigned so that resolution can be promptly effected.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 02-1010 (35481-73372).

Respectfully submitted,

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